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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,226	02/17/2004	Nobumasa Sasa	KON-1855	9478

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EXAMINER

MCCLENDON, SANZA L

ART UNIT PAPER NUMBER

1711

DATE MAILED: 03/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

GM

Office Action Summary	Application No.	Applicant(s)	
	10/780,226	SASA, NOBUMASA	
	Examiner	Art Unit	
	Sanza L. McClendon	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/21/04</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10/718,408 and 2004/0102543. Although the conflicting claims are not identical, they are not patentably distinct from each other because they appear to comprise overlapping subject matter. The difference between the two applications is the teaching that the epoxidized fatty acid ester in 10/718,408 does not expressly teach that said epoxide groups could be alicyclic as found in the instant claims. However, the examiner deems that alicyclic epoxy-modified by fatty acids as found in 10/718,408 are encompassed since there is no teaching/suggestion that one of ordinary skill in the art informed of 10/718,408 (2004/0102543) should not use fatty acid-modified alicyclic epoxide compounds.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3-6 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Hiwara et al (6,166,100).

Hiwara et al teaches radiation curable cationically polymerizable-pigmented compositions. Said compositions comprise (A) a cationically polymerizable binder component containing at least one resin or compound selected from the groups consisting of (A-1) a cationically polymerizable acrylic resin having either a epoxide or oxetane groups, (A-2) fatty acid modified epoxy compound with (B) a cationic photoinitiator and (C) a color pigment. In addition, said composition can comprise other cationically polymerizable materials (A-3) such as oxetane compounds, epoxy compounds, vinyl ether compound or bicycle-orthoester compounds. Said fatty acid modified epoxy compound is an epoxy compound containing at least one aliphatic hydrocarbon group, as defined in column 8, and at least one epoxy groups in the molecule. It is prepared by partly modifying epoxy groups of an epoxy with a fatty acid, such as those found in column 8. Said epoxy group contained in the fatty acid modified compound may include an alicyclic epoxy group. This anticipates applicant's instant claim 1. (A-3) when chosen to be either an oxetane or vinyl ether anticipates claim 3. Said cationic photoinitiator is disclosed are being onium salt-see columns 11-15. This anticipates claim 4. The pigments of Hiwara et al can be found in column 15, thus claim 5 is anticipated. Hiwara et al teaches as one optional component a pigment-dispersing agent-see column 15, line 53. Any substrate printed with the ink composition of Hiwara et al anticipates claim 9.

3. Claims 1, 3-6 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Makoto et al (JP 08-143806).

Makoto et al teaches ink compositions curable by radiation. Said ink compositions comprise (A) a compound having 1-4 oxetane rings, (B) a cationic polymerization initiator, and pigments. Said composition can additionally

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comprise other cationically polymerizable compounds such as epoxy compound and vinyl ether compounds. Said epoxy compounds preferably are alicyclic compounds—see [0056]. Compound 31 in [0059] appears to anticipate applicants epoxy compound of claim 1. The pigments can be found in section [0055]. The vinyl ethers can be found in section [0061]. The cationic initiators can be found in section [0049] to [0055]. Makoto et al teaches adding processing aids as optional components. It is deemed that pigment dispersion aids are included in processing aids. Any substrate printed with the ink composition of Hiwara et al anticipates claim 9. Per examples, Makoto et al teaches using an inkometer to print the ink, the examiner deems that this anticipates applicant's ink jet ink limitation in the preamble.

Claim Rejections - 35 USC § 102/35 USC § 103

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7-8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hiwara et al (6,166,100) as evidenced by Bassemir et al.

Hiwara et al does not expressly teach said ink has a viscosity at 25 °C of 5 to 50 mPa*s, however it is known in the art of inks for ink-jet printing that said ink-jet inks typically have a viscosity in the range from 1 to 5 mPa*s as found in Bassemir et al. Therefore it would have been obvious for an artisan of ordinary skill in the art to prepare an ink composition as

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found in Hiwara et al having a viscosity of at least 5 mPa*s. The motivation would have been a reasonable expectation of successfully jetting said ink composition onto a substrate without bleeding on the substrate or clogging the nozzle in the absence of evidence to the contrary.

With regards to claim 7, it is noted that Hiwara et al does not expressly teach the average particle diameter of said pigments. However the examiner deems that since applicant has not established the criticality of said average particle size, said ink composition would have worked as well with any average size particle diameter for the pigment in the absence of evidence to the contrary and/or unexpected results.

Allowable Subject Matter

7. Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


8. The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to teach epoxy compounds having the formula found in said claim in an inkjet ink composition as found in claim 1.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L. McClendon whose telephone number is (571) 272-1074. The examiner can normally be reached on Monday through Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sanza L. McClendon
Examiner

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